

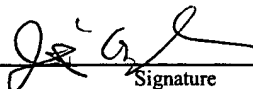
DOCKET NO.: HA0794-NP

10/775,443

CERTIFICATE OF MAILING

hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Jing G. Sun, Ph.D.  
Type or print name

  
Signature

August 11, 2005  
Date

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: **Bisacchi, G. S.** Examiner: **Aulakh, Charanjit**

Serial No.: **10/775,443** Group Art Unit: **1625**

Filed: **February 10, 2004** Confirmation: **9406**

For: **BENZENE ACETAMIDE COMPOUNDS USEFUL AS SERINE  
PROTEASE INHIBITORS**

Mailstop:  
Assistant Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**RESPONSE TO RESTRICTION REQUIREMENT**

These remarks are being filed in response to the Office Action mailed July 22, 2005. In view of the remarks hereinafter, reconsideration of the application is respectfully requested.

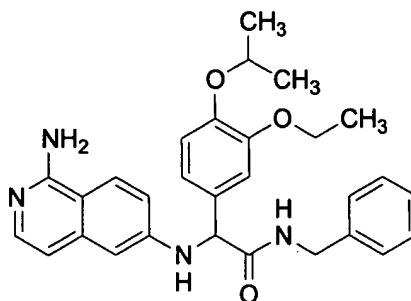
The Examiner has required restriction in the above-identified application and has divided the instant application into 10 inventions I through X as described in the Office Action.

The Office Action contends that the inventions I through X are patentably distinct, each from the other since they are structurally so divergent that a reference showing compounds of invention I would not render compounds of invention II through X *prima facie* obvious. Search required for e.g., compounds of invention I in class 564, subclass 123 is not the same search required for e.g., compounds of invention II in class 546, subclass 139 and therefore, constitutes a burdensome search. Accordingly, the

Office Action requests that applicants elect a single invention to be examined even though the requirement can be traversed.

In response, applicants respectfully elect, with traverse, to prosecute the invention of Group II, namely claims 1-27, drawn to compounds of formula (I) where Z represents isoquinoline group, pharmaceutical compositions containing these compounds and a method of using these compounds.

No election of species was required. However, in order to assist the PTO, Applicants suggest that the compound of Example 5 (2-(1-Amino-isoquinolin-6-ylamino)-N-benzyl-2-(3-ethoxy-4-isopropoxy-phenyl)-acetamide, page 58) be used as a starting point to search the elected Group II, which has the following structure:



Said elections are being made for searching purposes only and should not be construed as a limitation of the compounds of the present invention. Claims 1-27 read on the elected example.

Applicants respectfully submit that Groups I through X are merely different embodiments of a single inventive concept, for which a single patent should issue. It is too restrictive to divide one single inventive concept into ten separate inventions only based on a single variable Z. The Office Action contends that Groups I-X are distinct, as is shown by their different classification. Applicants respectfully submit that the classification system was implemented to facilitate searching and not to serve as a basis for requiring an applicant to divide up his/her application. In and of itself, the classification system is not a basis for requiring restriction and applicants respectfully submit does not lend support to the position set forth in the Office Action.

**DOCKET NO.: HA0794-NP**  
**10/775,443**

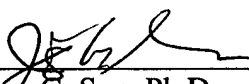
In addition, applicants respectfully submit that, in contrast to the Office Action's contention, a serious burden would not be imposed upon the Examiner to perform a complete search of the defined areas on the grounds that all of the claims are dependent and related to compounds of formula (I).

In view of the forgoing, reconsideration and withdrawal of the requirement for election, and consideration of all the subject matter of the claims is requested.

If the Examiner has any questions or believes further discussion will aid examination and advance prosecution of the application, a telephone call to the undersigned is invited.

Respectfully submitted,

Date: August 11, 2005

  
\_\_\_\_\_  
Jing G. Sun, Ph.D.  
Agent for Applicants  
Registration No. 45,914  
Telephone No. (609) 252-3791  
Facsimile No. (609) 252-4526

**Please forward all future correspondence relating to this application to:**

Stephen B. Davis  
Patent Department  
Bristol-Myers Squibb Company  
P.O. Box 4000  
Princeton, NJ 08543-4000